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OFFICE OF PETITIONS

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In re Application of :
Liang, et al. :
Application No. 09/637,764 :
Filed: August 10, 2000 :
Attorney Docket No. 36912/CM/S61 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed November 5, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure file an appeal brief after the filing of a Notice of Appeal. A Notice of Appeal was filed on September 11, 2006. A timely appeal brief was not filed, and the application became abandoned on November 12, 2006. A Notice of Abandonment was mailed October 1, 2007¹.

A grantable petition under 37 CFR 1.137(a)² must be accompanied by: (1) the required reply,³ unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

¹ The Notice of Abandonment incorrectly states that the application became abandoned for failure to respond to the final Office action. In fact, the Notice of Appeal and request for extension of time within the month were a proper and timely response to the final Office action. The application became abandoned for failure to file an appeal brief thereafter. The request for an extension of time within the third month is necessary because, although a response to the final Office action was filed within two months of the final Office action, the Advisory Action was mailed May 22, 2006. The shortened statutory period for reply ended on June 8, 2006—three months after the final Office action was mailed and the latest date between the date the Advisory Action was mailed and three months after the final rejection was mailed.

² As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

³ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks items (1) and (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”⁴

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁵

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁶

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁷

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁸

⁴*Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), *aff’d without opinion* (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); *see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”))

⁵*Commissariat A L’Energie Atomique et al. v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁶*Haines v. Quigg*, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing *Camp v. Pitts*, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); *Beerly v. Dept. of Treasury*, 768 F.2d 942, 945 (7th Cir. 1985); *Smith v. Mossinghoff*, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁷*Ray v. Lehman*, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing *Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁸*Id.*

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?" Nonawareness of a PTO rule will not constitute unavoidable delay.¹⁰

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that miscommunications between the examiner and Special Programs Examiners department resulting in the allegedly erroneous information being given to petitioner regarding the sufficiency of the May 9, 2006.

Relative to item (1) above, the undersigned contacted Examiner William Neuder regarding the amendment filed November 5, 2007. Examiner Neuder indicated that the amendment overcomes the rejections made in the final Office action, but that the Special Program Examiner has previously determined that the oath is defective and that issue has not been addressed in the amendment filed November 5, 2007. Examiner Neuder further indicated that new amendments at the time of allowance require a new oath or declaration, which did not accompany the amendment filed November 5, 2007. The petition must be dismissed, in part, because the response filed November 5, 2007, is incomplete.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reasons petitioner's argument must necessarily fail are addressed below.

The alleged miscommunications between the examiner and Special Program Examiners regarding the sufficiency of the response filed May 9, 2006, are unfortunate and undoubtedly unduly complicated the prosecution of the application. As a rule, practitioner's are dissuaded from relying on the oral representations of the employees of the USPTO and reliance on such oral representations cannot be a cause for unavoidable delay. Further, the USPTO's failure to notify applicant of a defect in the response of May 9, 2006, in time for the applicant to take corrective action is not a cause for unavoidable delay. Further to this point, Section 711.03(c) of the *Manual of Patent Examination Procedure*, states:

⁹See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

¹⁰See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. Likewise, as a "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay. See *Krahn*, 15 USPQ2d at 1825. Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Notwithstanding, petitioner had the foresight to file a Notice of Appeal before the expiration of the maximum statutory period for reply. The application did not become abandoned because of the miscommunications between the USPTO employees, but became abandoned for failure to file a timely appeal brief after the filing of the Notice of Appeal. The petition does not establish that the entire delay in filing an appeal brief or other appropriate filing after the filing of the Notice of Appeal-- from the due date for the reply until the filing of a grantable petition--was unavoidable. The petition is dismissed, accordingly.

The petition fee of \$ \$510.00 will be charged to deposit account 03-1728.

The amount of \$1020.00 for the fee for the extension of time within the third month necessary for the Notice of Appeal to be considered timely will be charged to deposit account 03-1728.

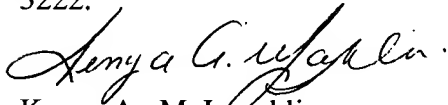
Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee (\$1,540.00 for a large entity and \$770.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.

A handwritten signature in cursive script, appearing to read "Kenya A. McLaughlin".

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions